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| <b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>  |                                 | Docket Number (Optional)<br><b>03-0128 81615</b> |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]<br><br>on _____<br><br>Signature _____<br><br>Typed or printed name _____   |                                 | Application Number<br><b>10/695,853</b>          | Filed<br><b>10/28/2003</b>         |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
|   |                                 | First Named Inventor<br><b>PAPPU, Krishna K.</b> |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
|   |                                 | Art Unit<br><b>2825</b>                          | Examiner<br><b>Parihar, Suchin</b> |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).<br/>Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td><u>/ Eric James Whitesell /</u></td></tr><tr><td></td><td>Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest.<br/>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.<br/>(Form PTO/SB/96)</td><td><u>Eric J. Whitesell</u></td></tr><tr><td></td><td>Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record.      <b>38657</b></td><td><u>858-350-9257</u></td></tr><tr><td>Registration number _____</td><td>Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</td><td><u>02/05/2008</u></td></tr><tr><td>Registration number if acting under 37 CFR 1.34 _____</td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.<br/>Submit multiple forms if more than one signature is required, see below*.</p> |                                 |  |                                    | <input type="checkbox"/> applicant/inventor. | <u>/ Eric James Whitesell /</u> |  | Signature | <input type="checkbox"/> assignee of record of the entire interest.<br>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.<br>(Form PTO/SB/96) | <u>Eric J. Whitesell</u> |  | Typed or printed name | <input checked="" type="checkbox"/> attorney or agent of record. <b>38657</b> | <u>858-350-9257</u> | Registration number _____ | Telephone number | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. | <u>02/05/2008</u> | Registration number if acting under 37 CFR 1.34 _____ | Date |
| <input type="checkbox"/> applicant/inventor.  | <u>/ Eric James Whitesell /</u> |  |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
|   | Signature                       |  |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
| <input type="checkbox"/> assignee of record of the entire interest.<br>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.<br>(Form PTO/SB/96)   | <u>Eric J. Whitesell</u>        |  |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
|   | Typed or printed name           |  |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
| <input checked="" type="checkbox"/> attorney or agent of record. <b>38657</b>   | <u>858-350-9257</u>             |  |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
| Registration number _____   | Telephone number                |  |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.  | <u>02/05/2008</u>               |  |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |
| Registration number if acting under 37 CFR 1.34 _____   | Date                            |  |                                    |  |                                 |  |           |   |                          |  |                       |   |                     |                           |                  |  |                   |   |      |

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| <input type="checkbox"/> *Total of _____ forms are submitted. |
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## **BRIEF IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW**

In response to the first office action mailed on 07/24/07 and the final office action mailed on 12/31/2007, please enter the following brief in support of the attached pre-appeal request for review. A notice of appeal and the fee therefor are submitted herewith.

### **ARGUMENTS**

#### ***The rejection fails to provide motivation for making the proposed modification of Beausang by Nadeau***

Regarding Claims 1, 10, 19, and 20, the rejection (P04 §5) in the first office action alleges that one with ordinary skill in the art would have been motivated to make the proposed modification of *Beausang* by *Nadeau* “. . . because the tracing step as taught by Nadeau-Dostie et al. would provide for the necessary identification of scan cells for partitioning of scan cells into subgroups that correspond to a common signal domain in *Beausang*”.

The rejection (P08, §17) in the first office action further alleges that providing the necessary identification of scan cells for partitioning of scan cells into subgroups that correspond to a common signal domain is lacking in *Beausang* as follows: “Beausang, in FIG, 2A at 315, then implies the ability to determine which scan chains [i.e., groups of cells or segments] are compatible with a particular clock domain [i.e. have the same clock source as another cell or cells]. However, Beausang does not explicitly teach a method or process that can determine whether a cell has a clock domain that is identical or compatible with another cell or group of cells. This lacking step is taught by Nadeau-Dostie.” Accordingly, the rejection admits that partitioning of scan cells into subgroups that correspond to a common signal domain, i.e., the same clock source, is necessary to *Beausang* and is also missing in *Beausang*. Because the rejection alleges that partitioning of scan cells into subgroups that correspond to a common signal domain is in fact necessary to *Beausang* and is also missing in *Beausang*, it is reasonable to interpret the rejection as alleging that *Beausang* does not sufficiently disclose the necessary step of determining which scan chains have the same clock source. If the allegations made by

the rejection were true, then *Beausang* would fail to satisfy the requirement of enablement under 35 USC § 112. However, the USPTO has determined that *Beausang* met the requirement of enablement under 35 USC § 112 when the *Beausang* patent was granted. Because the USPTO has determined that *Beausang* met the requirement of enablement under 35 USC § 112, the presumption is established that each and every step necessary to *Beausang* is disclosed sufficiently to enable one of ordinary skill in the art to make and use the invention disclosed and claimed in *Beausang*. Because each and every step necessary to *Beausang* is presumed to be sufficiently disclosed under 35 USC § 112, the allegation that *Beausang* lacks sufficient disclosure for determining which scan chains have the same clock source is proven false. Because the allegation that *Beausang* lacks sufficient disclosure for determining which scan chains have the same clock source is proven false, the argument presented by the rejection to support motivation for making the proposed modification of *Beausang* by *Nadeau* is unsubstantiated. Because the rejection fails to establish a motivation for make the proposed modification of *Beausang* by *Nadeau*, the rejection of Claims 1, 10, 19, and 20 lacks sufficient support to substantiate a rejection under 35 U.S.C. § 103.

In the final office action, the rejection (P08 §17) alleges that the statements in the previous office action were misinterpreted to mean that *Beausang* does not meet the enabling requirement. However, the rejection does not contest the interpretation that *Beausang* lacks the step taught by *Nadeau* relied on to support the rejection, nor does the rejection contest the interpretation that partitioning of scan cells into subgroups that correspond to a common signal domain, i.e., the same clock source, is missing in *Beausang*. However, the final rejection (P08 §17) argues that this lacking step is necessary to the claimed invention, not to *Beausang*. The final rejection (P08-09 §19) alleges that *Beausang* would be improved by the proposed modification because a teaching would be provided to help determine which scan chains belong to which clock domains. However, the final rejection (P08 §17) insists that the step of determining which scan chains belong to which clock domains is not necessary to *Beausang*. Accordingly, the rejection maintains that the step of determining which scan chains belong to which clock domains is not necessary to achieving the intended purpose of *Beausang*. Because

the rejection insists that *Beausang* does not require the step of determining which scan chains belong to which clock domains to achieve its intended purpose, the rejection fails to show how *Beausang* would benefit from the proposed modification. Because the rejection fails to show how *Beausang* would benefit from the proposed modification, the rejection fails to provide motivation in the prior art for making the proposed modification. Because the rejection fails to establish a motivation for make the proposed modification of *Beausang* by *Nadeau*, the rejection of Claims 1, 10, 19, and 20 lacks sufficient support to substantiate a rejection under 35 U.S.C. § 103.

Further, *Beausang* (C26 L40 – C27 L13; F2A:315) discloses a computer program that partitions scan segments by clock domain. Because *Beausang* already discloses means for determining which scan chains have the same clock source, there is no lack in *Beausang* that would benefit from the proposed modification by *Nadeau* as alleged by the rejection. Because *Beausang* would not benefit from the proposed modification by *Nadeau*, the argument presented by the rejection to support a motivation to make the proposed modification of *Beausang* by *Nadeau* is unsubstantiated. Because the rejection fails to establish a motivation for make the proposed modification of *Beausang* by *Nadeau*, the rejection of Claims 1, 10, 19, and 20 lacks sufficient support to substantiate a rejection under 35 U.S.C. § 103.

In view of the above, the rejection fails to show that the proposed modification would improve *Beausang* in achieving its intended purpose and fails to show that *Beausang* would realize a benefit that would motivate one of ordinary skill in the art to make the proposed modification of *Beausang* by *Nadeau*. Because the rejection fails to show that the proposed modification would improve *Beausang* in achieving its intended purpose and fails to show that *Beausang* would realize a benefit that would motivate one of ordinary skill in the art to make the proposed modification, the rejection fails to establish motivation for making the proposed modification. Because the rejection fails to establish motivation for making the proposed modification, the rejection of Claims 1 and 10 lacks sufficient support to substantiate a rejection under 35 U.S.C. § 103. The rejection of dependent Claims 2-9 and 11-18 is traversed for the same reasons presented in defense of Claims 1, 10, 19, and 20.

***The proposed modification of Beausang by Nadeau fails to result in the claimed invention***

Even if there were motivation to make the modification of *Beausang* by *Nadeau* proposed by the rejection, the proposed modification would fail to result in the claimed invention, because the rejection fails to show that *Beausang* discloses step (g) recited in Claims 1 and 10 of inserting each cell traced from the net to an input port of the cell in the corresponding list of cells for the common signal domain associated with the signal driver. Further, even if the rejection had included step (g) in the proposed modification of *Beausang* by *Nadeau*, the rejection fails to show that *Beausang* would benefit from including step (g). Because the rejection fails to show that the proposed modification of *Beausang* by *Nadeau* includes step (g) recited in Claims 1 and 10, and because the rejection fails to show that *Beausang* would benefit from including step (g), the modification proposed by the rejection fails to result in the claimed invention. Because the modification proposed by the rejection fails to result in the claimed invention, the rejection of Claims 1, 10, 19, and 20 lacks sufficient support to substantiate a rejection under 35 U.S.C. § 103.

Respectfully submitted,  
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